

(hereinafter, GB '195); and Claims 63-67 were rejected under 35 U.S.C. §103(a) as being unpatentable over Prueitt in view of Elton and further in view of Donaldson et al. (US Patent No. 5,339,062, hereinafter Donaldson).

In the outstanding Office Action, all of the pending claims were rejected based upon a combination of Prueitt and Elton, and in some cases, a tertiary reference GB '195 or Donaldson is asserted. Applicants maintain their traversal of the rejection based on the proposed combination of Prueitt and Elton for reasons similar to those set forth in the Amendment filed October 9, 2001. All of the arguments supporting Applicants' traversal of the rejections set forth in the Amendment filed October 9, 2001 are incorporated herein by reference.

In the Response to Arguments section of the outstanding Office Action, the Examiner rebuts Applicants' argument that the cable described in Elton cannot be formed into coils. The Office Action asserts that this argument "is refuted by the disclosure of Elton et al which states in the abstract and in column 1 line 26 that the conductor may be used in windings in a dynamoelectric machine."¹

In response, Applicants respectfully submit that the Examiner has mischaracterized this particular passage from Elton. As discussed in the Amendment filed October 9, 2001, Elton is a continuation of the application that led to U.S. Patent No. 4,853,565 (hereinafter Elton '565), which includes a more complete context for the passage cited in the outstanding Office Action. The invention in Elton is the use of a pyrolyzed glass fiber layer in various applications, for example, as a layer of a bar-type winding of a dynamoelectric machine, as layers of a cable, and as a coating for a housing for electronic components. Given this background, when the complete paragraph of the passage of Elton is read (i.e., col. 1, lines 22-35), it is clear that the windings of the dynamoelectric machine being discussed in the

¹ See Office Action dated October 24, 2001, at p. 4.

passage cited in the Office Action are actually conventional bar-type windings, or armature bars: “[h]eavily insulated electrical windings, or armature bars, are disposed in the slots.”² It is therefore respectfully submitted that the cited passage of Elton is not suggesting that the cable illustrated in Figure 1 of Elton may be used as a winding of a dynamoelectric machine.

The Office Action further asserts that “[e]ven if the device of Elton et al cannot be formed into coils, the teaching of Elton et al that coaxial semi-conductors protect a central conductor is applicable to any conductor.”³

In response to this assertion, Applicants respectfully submit that the asserted prior art does not teach or suggest replacing the windings of Prueitt with the conductor of Figure 1 of Elton.

For a proper obviousness rejection based on a combination of references, there must be evidence in the references themselves showing that there was a motivation to combine the references, or from what was known to one of ordinary skill in the art, not merely that it was feasible to combine the references. It is respectfully submitted that there is no evidence (1) of a desirability to modify the winding used in Prueitt, (2) to suggest that the cable described in Elton could be used as a winding in a superconducting magnetic energy storage (SMES) device, nor (3) that one of ordinary skill in the SMES art would have a reasonable expectation of success if the SMES device in Prueitt was modified to operate with cable windings that have the structure of the cable described in Elton.

Consequently, the motivation asserted in the outstanding Office Action is unsupported by any evidence indicating that the proposed combination of Prueitt and Elton is desirable or technically feasible. Accordingly, it is respectfully submitted that one of ordinary skill in the SMES art would not have been motivated to combine the cable in Elton with the SMES device in Prueitt.

² See Elton, at column 1, lines 25-35.

³ See Office Action dated October 24, 2001, at p. 5.

In the recent CAFC decision of *In re Lee*, 61 USPQ2d 1430 (CAFC 2002), the court stressed the requirement for basing obviousness rejections on evidence, and not on conclusory statements made by an Examiner to support a rejection:

When patentability turns on the question of obviousness, the search for and analysis of the prior art includes evidence relevant to the finding of whether there is a teaching, motivation, or suggestion to select and combine the references relied on as evidence of obviousness.⁴

...In finding the relevant facts, in assessing the significance of the prior art, and in making the ultimate determination of the issue of obviousness, the Examiner and the Board are presumed to act from [the viewpoint of “the person having ordinary skill in the art to which said subject matter pertains”]. Thus, when they rely on what they assert to be general knowledge to negate patentability, the knowledge must be articulated and placed on the record. The failure to do so is not consistent with either effective administrative procedure or effective judicial review. The board cannot rely on conclusory statements when dealing with particular combinations of prior art and specific claims, but must set forth the rationale on which it relies.⁵

It is respectfully submitted that the rejections set forth in the outstanding Office Action and the rebuttal of Applicants arguments are based on conclusory statements, and not based on evidence as is required to be consistent with the guidance set forth in *In re Lee*.

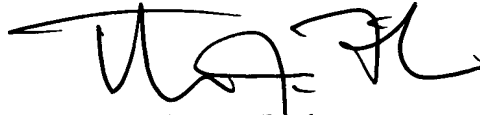
Furthermore, as is clearly set forth in the MPEP at § 2142, “[t]he examiner bears the initial burden of factually supporting any *prima facie* conclusion of obviousness”, and “[w]ith regard to rejections under 35 U.S.C. 103, the examiner must provide evidence which as a whole shows that the legal determination sought to be proved (i.e., the reference teachings establish a *prima facie* case of obviousness) is more probable than not.” Applicants respectfully submit that the Examiner has not met this burden.

⁴ *In re Lee*, 61 USPQ2d 1430, 1433 (CAFC 2002).

⁵ *Id.* at 1435

Consequently, in light of the foregoing comments, as well as the arguments set forth in the Amendment filed October 9, 2001, it is respectfully submitted that the invention defined by Claims 37-79 is patentably distinguishing over the asserted prior art. The present application is therefore believed to be in condition for formal allowance and an early and favorable reconsideration of this application is respectfully requested.

Respectfully submitted,
OBLON, SPIVAK, McCLELLAND,
MAIER & NEUSTADT, P.C.



Bradley D. Lytle
Registration No. 40,073
Attorney of Record
Thomas J. Fisher
Registration No. 44,681



22850

(703) 413-3000

Fax #: (703) 413-2220

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